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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
07/728,428	07/11/1991	JO ANN M. CANICH	89B010-D-1	5216

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EXAMINER	
RABAGO, ROBERTO	
ART UNIT	**PAPER NUMBER**
1713	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	07/728,428	CANICH, JO ANN M.	
	Examiner	Art Unit	
	Roberto Rábago	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 November 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *27,44-56 and 60-122* is/are pending in the application.

4a) Of the above claim(s) *83-121* is/are withdrawn from consideration.

5)☒ Claim(s) *27 and 44-47* is/are allowed.

6)☒ Claim(s) *48-56,60-82 and 122* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 27, 44-56, 60-82 and 122, drawn to compounds, classified in class 556, subclass 53.

   II. Claims 83-121, drawn to polymerization process, classified in class 526, subclass 161.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product would be useful in chemical reactions other than polymerization.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Newly submitted claims 83-121 are directed to an invention that is independent or distinct from the invention originally claimed for the reasons set forth above. Since applicant has received an action on the merits for the originally presented invention (group I), this invention has been constructively elected by original presentation for

prosecution on the merits. Accordingly, claims 83-121 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Claims 83-121 are not eligible for the protections of 37 CFR 1.129(b)(I), in view of exception (ii). Specifically, a restriction was not made in this application prior to April 8, 1995 between compound (I) and polymerization process (II) because applicants had not previously presented claims to process of polymerization.

Double Patenting

2. Claims 48-56 and 60-63 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 7,041,841, 5,621,126, RE 37,788 and 6,617,466 for the reasons set forth in items 9-12 of the Office action mailed 3/8/2006. New claims 64-82 are furthermore rejected on the same grounds and for the same reasons.

Applicant's arguments filed 11/27/2006 have been fully considered but they are not persuasive. Applicants argue that a two-way test for obviousness-type double patenting is required, and that the patented claims could not have been filed in the instant application. Requirement for a two-way test is not contested; however, since the patented claims recite embodiments which are explicitly covered in the instant claims, applicants' argument regarding the need for separate filings is not accepted. Specifically: (a) the features identified in '841 (x=2 or 4) are recited in the instant claims wherein x=0, 1, 2, 3, or 4; (b) the features identified in '126 and RE '788 (R' bonded through 1° or 2°) are recited in the instant claims wherein R = C_{1-20} hydrocarbyl, further

in light of claims 73-74, which specifically identify numerous species bonded through a 1° or 2° carbon atom; (c) no specific traversal argument has been made regarding '466.

Claim Objections

4. Claims 48, 66, 68, 70-74 are objected to because, in lines 2-3 of the text, "Hr" should be "Hf."

Claim Rejections - 35 USC § 102

5. Claims 64, 66 and 68 are rejected under 35 U.S.C. 102(e) as being anticipated by Tomotsu et al. (US 5,276,117).

Reference Example 1 discloses $Me_5CpTi(OMe)_3$ with ½ molar equivalent of ethylene glycol, including all claimed limitations.

6. Claims 48-50, 53-56, 61, 63-65, 67-75 and 77-82 are rejected under 35 U.S.C. 102(g) as unpatentable over the lost count in Interference No. 103,819. Copies of the count and judgment in Interference No. 103,819 were mailed to applicant on 1/26/1998 and 11/19/1998, respectively, and are therefore not provided again herewith.

The count of Interference No. 103,819 sets forth a catalyst for addition polymerization including a titanocene having a bidentate ligand comprising a Cp group and a group 15 heteroatom bridged via a group 14 or 15 element. The metallocene specified in the count is clearly within the scope of the instant claims.

Applicant's arguments filed 11/27/206 have been fully considered but they are not persuasive. Applicant argues entitlement to the Ti subgenus solely in view of a single sentence in the decision in interference 102,954: "... a determination has already been made that the titanium subgenus is separately patentable from the zirconium, hafnium, titanium genus involved in this interference." The portion of the decision which contained this text was not an full analysis of the issues regarding the relationship between the Ti subgenus to the larger genus, but was in response to motions. Absent from the decision is any substantive discussion of whether the larger genus is patentable over the Ti subgenus. What is clear on the record is that in applicant's requesting negative judgment in the '819 interference, resulting in judgment being awarded to the opponent party, the opponent party is entitled to a patent containing claims corresponding to the count, and the instant applicant is not. If applicant's argument were to prevail, applicant could receive a patent for subject matter which they were expressly denied a patent in the '819 interference. This issue is clearly exemplified in instant claim 75, wherein the Ti species of metallocene is exactly the same as that of opponents' claim 149 of the '819 interference, stated to correspond to the count. There is no reasonable basis for applicant to argue entitlement to the Ti species of instant claim 75; furthermore, any implication that applicant is entitled to a broader scope which includes Ti species which are within the scope of the '819 interference is directly contrary to the fundamental concept that a genus is never patentable over a narrower species.

Claim Rejections - 35 USC § 103

7. Claims 64-69 and 122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell et al. (US 5,045,517).

Reference Examples 2-12 disclose a variety of Ti complexes within the scope of the claims, including CpTi phenoxy dichloride and CpTi tris-dimethylamide. Missing from the example is the inclusion of component L. However, one of ordinary skill in the art would be motivated to add a component L because patentee suggests the addition of alcohols at col. 2, lines 31-39.

Applicant's arguments filed 11/27/2006 have been fully considered but they are not persuasive. Applicant's argument is not accepted because applicants' assertion that the claimed group L is "not a separate molecule" is not understood, and applicants have provided no explanation for determining the meaning of "separateness" of a molecule.

Allowable Subject Matter

8. Claims 27 and 44-47 are allowed.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Roberto Rábago
Primary Examiner
Art Unit 1713

RR
February 20, 2007